

USSN: 09/647,748

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range of about 3 to 20 mm, and said adhesive layer being provided on the surface of said first paper layer having a blending ratio of short fibers to wood pulp that is larger than the blending ratio of short fibers to wood pulp of said second paper layer.

A version with markings to show changes made in the claim(s) relative to the previous version of the claim(s) is attached.

### Remarks

Claims 1 and 2 have been amended. Claims 1-4 are pending.

Examination and reconsideration of the application as amended is requested.

### § 112 Rejections

Claims 1-4 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant has amended claims 1 and 2 to clarify the term "different" for the Examiner. Support for this amendment can be found, for example, at page 3, line 30 to page 4, line 2 of the application as published in the PCT and filed in the United States. This amendment does not, and is not intended to, narrow the scope of the pending claims.

Claims 3 and 4 depend directly from claim 2. In summary, Applicant submits the rejection of claims 1-4 under 35 U.S.C. § 112, second paragraph, has been overcome, and that the rejection should be withdrawn.

### § 102 Rejections

Claim 1 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Canary (EP 0 488 727 A). Canary teaches laminated paperboard in the form of a ply comprising two layers formed from a mixture of polyolefin fibers and a softwood pulp. One of the layers is a higher content polyolefin fiber than the other layer.

Applicant has amended claim 1 to recite that the short fibers have a length within the range of about 3 to 20 mm. Support for this amendment can be found, for example, at page 5, line 16 of the application as published in the PCT and filed in the United States. Canary

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teaches that the polyolefin fibers have a maximum length of 2.5 mm. (See page 2, column 1, lines 36-39.) Therefore, the rejection of claim 1 under 35 U.S.C. § 102(b) as being anticipated by Canary has been overcome and should be withdrawn.

### **§ 103 Rejections**

Claims 2-4 stand rejected under 35 U.S.C. § 103 as being unpatentable over Nitto Denko Corp. (XP002112333 & JP 151427) in view of Canary.

The Examiner states that Nitto Denko Corp. teaches a masking tape with a thin porous sheet paper made of beaten wood pulp and short synthetic fiber is impregnated with rubber and/or synthetic resin. Additionally, the Examiner states that Nitto Denko Corp. teaches the advantage of having different amounts of impregnated rubber and/or resin at the front and rear surfaces to yield different densities to provide mechanical strength on one side and better compatibility for coating on the other side. The Examiner states that Nitto Denko Corp. shows all the elements of claims 2-4 except the backing as taught in Canary.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.

As stated above, the combination of references fail to teach all the limitations in the amended claims because Canary fails to teach short fibers having a length within the range of about 3 to 20 mm. Therefore, the rejection of claim 2 under 35 U.S.C. § 103 as being unpatentable over Nitto Denko Corp. in view of Canary has been overcome and should be withdrawn.

Claims 3-4 each add additional limitations to claim 2. Claim 2 is patentable for the reasons given above. Thus, claims 3-4 should likewise be patentable.

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In view of the above, it is submitted that the application is in condition for allowance. Reconsideration of the rejection is requested. Allowance of claims 1-4, as amended, at an early date is solicited.

Respectfully submitted,

May 6, 2002  
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RESPONSE TO 1-4-02 OA

**Version With Markings to Show Changes Made**

1. A paper backing, for supporting a secondary layer, which has a double-layer paper structure comprising a first paper layer and a second paper layer, said first paper layer and said second paper layer each being manufactured from wood pulp and short fibers having a length within the range of about 3 to 20 mm, wherein [the] said first layer has a blending ratio of short fibers to wood pulp larger than the blending ratio of short fibers to pulp in said second layer [and second paper layers have different blending ratios of short fibers to wood pulp].

2. An adhesive sheet comprising a paper backing and an adhesive layer provided on one of its surfaces, said paper backing having a double-layer paper structure comprising a first paper layer and a second paper layer, in which said first paper layer and said second paper layer each is manufactured from wood pulp and short fiber having a length within the range of about 3 to 20 mm, [and the first and second paper layers have different blending ratios of short fibers to wood pulp,] and said adhesive layer being provided on the surface of said first paper layer having a blending ratio of short fibers to wood pulp that is larger than the blending ratio of short fibers to wood pulp of said second paper layer.